

REMARKS / ARGUMENTS

The present application includes pending claims 1-57, all of which have been rejected. By this Amendment, claims 1-5, 7-18, 20-33, 35, 37-43, 46-49, and 56-57 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1-57 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-57 also stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-7, 10, 11, 15-21 and 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0097655, issued to Novak (hereinafter, Novak). Claims 8, 9, 12-14, 22, 23 and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak in view of U.S. Patent Publication No. 2004/0044627, issued to Russell, et al. (hereinafter, Russell). Claims 50-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak in view of *In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950) (hereinafter, *Japikse*). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 112

I. Rejection of Claims 1-57 Under 35 U.S.C. § 112, First Paragraph

The Applicant first turns to the rejection of claims 1-57 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office Action states the following:

Independent claims 1, 15, 30 and 46 contain the added limitation of responding by employing a user predefined association of the first user to a second user. The Examiner found no support in the specification that would enable one skilled in the art as to what or how the software responds by employing a user predefined association of the first user to the second user. Because claims 2-14, 16-29, 21-45 and 46-57 are dependencies of claims 1, 15, 30 and 46, they inherit the same deficiencies and are rejected on the same bases.

The Applicant respectfully disagrees and traverses this rejection. The limitations to claims 1, 15, 30 and 46 added in the July 26, 2006 response are clearly supported by specification and the drawings at, for example, paragraphs 10-16, 53, 57, 61, and 62. Nevertheless, the Applicant has amended claims 1, 15, 30, and 46 to further clarify the language used in the claims. Support for the amendments may be found at, for example, paragraphs 10-16, 53-57, and 61-62, as well as Figures 3 and 5 of the application. The Applicant submits that the amendments do not introduce any new matter.

II. Rejection of Claims 1-57 Under 35 U.S.C. § 112, Second Paragraph

The Applicant now turns to the rejection of claims 1-57 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant respectfully disagrees and traverses this rejection. The limitations to claims 1, 15, 30 and 46 added in the July 26, 2006 response are clearly supported by specification and the drawings at, for example, paragraphs 10-16, 53, 57, 61, and 62. Nevertheless, the Applicant has amended claims 1, 15, 30, and 46 to further clarify the language used in the claims. Support for the amendments may be found at, for example, paragraphs 10-16, 53-57, and 61-62, as well as Figures 3 and 5 of the application. The Applicant submits that the amendments do not introduce any new matter.

REJECTION UNDER 35 U.S.C. § 102

III. Novak Does Not Anticipate Claims 1-7, 10, 11, 15-21 and 24

The Applicant now turns to the rejection of claims 1-7, 10, 11, 15-21 and 24 under 35 U.S.C. 102(e) as being anticipated by Novak. With regard to the anticipation rejections under 102(b), MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

A. Rejection of Independent Claim 1 under 35 U.S.C. § 102 (e)

With regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Novak does not disclose or suggest at least the limitation of "the server software enables **authorization by the first user of a second user** of the media exchange network at a second location so that at least a portion of the authorized user transaction is performed with the second user, via a communication network, **without divulging the identity of the first user to the second user,**" as recited by the Applicant in independent claim 1. (emphasis added)

The Office Action states the following:

Novak further discloses (see Fig. 4) that the system comprises server software ... that responds by employing a user predefined association of the first user to the send user of the media exchange network to enable the completion of the identified user transaction with the second user, via a communication network, without divulging the identity of the first user (¶¶0030, 0090, 0093, 0094, 0096, 0098, 0099, 0103, 0106-0109, and 0120-0124) For example, the Examiner notes (with reference to Fig. 4) an embodiment in which the verification of identity credentials includes checking the identity credentials with a trusted third party (TTP) (¶0090). A license key (412) and an access key (414) is all that is needed to decrypt the digital content (¶¶(0096 and 0098). These keys are received by the set top box (see Fig. 4 and 0030). The set top box receives the digital content (404) from a content source (420). The user may obtain access to digital content based on the user's license (411) stored at the verification entity (406: in this case the trusted third party). The license (411) is not tied to the user's set top box. The user may view the program using another set top box by simply inserting his or her smart card (410) and/or providing the

necessary pass code, pass phrase, biometric data or the like (¶0103). In this manner the transaction is enabled without divulging the identity of the user to a vendor (either the broadcast center (110) or the sources (420) (¶0099). Furthermore, the first user can transfer all or a portion of the license to a second user (¶¶0120-0124).

See the Office Action at pages 5-6. Regardless of whether it is true or not, the Applicant submits that the above argument is now moot in light of the current claim amendments disclosed above. The Examiner relies primarily on paragraphs 0030, 0090, 0093, 0094, 0096, 0098, 0099, 0103, 0106-0109, and 0120-0124 of Novak. The Applicant submits that Novak, including paragraphs 0030, 0090, 0093, 0094, 0096, 0098, 0099, 0103, 0106-0109, and 0120-0124 of Novak, does not disclose or suggest any authorization by the first user of a second user, as claimed by the Applicant in claim 1. For example, Novak discloses that the authorization/authentication functions are performed exclusively by a separate verification entity 406, prior to release of any content from the content source 420. See Novak, paragraphs 0082-0086. *Novak does not disclose or suggest at least two users at two separate locations*, where the first user authorizes the second user so that at least a portion of the authorized user transaction is performed at least with regard to the second user, as claimed by the Applicant in claim 1.

With regard to Figure 7 of Novak, even though Novak discloses that a user may use his smart card 410 at another set top box (presumably at the same or a

different location), **Novak does not disclose at least two separate users at two separate locations where the first user authorizes the second user.** The Applicant submits that the Novak scenario is clearly different from what is recited by the Applicant with regard to at least claim 1.

With regard to Figure 8 and corresponding paragraphs 0120-0124 of Novak, Novak discloses a **transfer** of the license (or a portion of the license). By definition, "transfer" implies that the transferor (user 402a) parts completely with any rights relating to content covered by the transferred license. The transferee (user 402b) is then the rightful owner of the content covered by the transferred license. **There is no authorization by the first user of the second user without divulging the identity of the first user.** The Applicant submits that this scenario is also different from what the Applicant recites in claim 1.

The Examiner states the following in the Office Action with regard to the anonymity limitation of claim 1:

In this manner the transaction is enabled without divulging the identity of the user **to a vendor** (either the broadcast center (110) or the sources (420) (¶0099). (emphasis added)

See the Office Action at page 6. The Applicant points out that the anonymity limitation of claim 1 ("without divulging the identity of the first user to the second user") relates to the first and the second user, and does not relate to the first user and the vendor, as stated by the Examiner.

Therefore, the Applicant submits that Novak does not disclose or suggest at least the limitation of "the server software enables authorization by the first user of a second user of the media exchange network at a second location so that at least a portion of the authorized user transaction is performed with the second user, via a communication network, without divulging the identity of the first user to the second user," as recited by the Applicant in independent claim 1. Accordingly, independent claim 1 is not anticipated by Novak and is allowable. Independent claims 15, 30 and 46 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 15, 30 and 46 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-7, 10, 11, 16-21 and 24

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 15 under 35 U.S.C. § 102(e) as being anticipated by Novak has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-7, 10, and 11, and 16-21 and 24 depend from independent claims 1 and 15, respectively, and are, consequently, also respectfully submitted to be allowable.

Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-7, 10, 11, 15-21 and 24.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., "citing *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima*

facie case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

IV. The Proposed Combination of Novak and Russell Does Not Render Claims 8, 9, 12-14, 22, 23 and 25-27 Unpatentable

Claims 8, 9, and 12-14, and 22, 23 and 25-27 depend from independent claims 1 and 15, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. Russell does not make up for the deficiencies in Novak. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 8, 9, 12-14, 22, 23 and 25-27.

V. The Proposed Combination of Novak and Japikse Does Not Render Claims 50-55 Unpatentable

Claims 50-55 depend from independent claim 46, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. Japikse does not make up for the

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deficiencies in Novak. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 50-55.

CONCLUSION


Based on at least the foregoing, the Applicant believes that all claims 1-57 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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